

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF PENNSYLVANIA**

INSTITUT PASTEUR and CENTRE  
NATIONAL DE LA RECHERCHE  
SCIENTIFIQUE,

Plaintiffs,

v.

ADAM J. SIMON, Ph.D.,

Defendant.

CIVIL ACTION

No. 98-727

**MEMORANDUM/ORDER**

**August 16, 2005**

Before this court is Plaintiffs' Motion to Strike the Reply Expert Report of John McDonnell, and Portions of the Reply Expert Report of Russell L. Parr, and to Limit Testimony Offered by Walter Hill. For the reasons stated below, plaintiffs' motion will be granted in part and denied in part.

**Walter Hill and John McDonnell**

On February 24, 2005, Simon moved to strike the expert report of Nancy J. Linck, a lawyer who has served as Solicitor of the Patent and Trademark Office ("PTO"), "on the grounds that she improperly renders opinions that are pure legal conclusions which usurp the role of the Court and invade the province of the jury." Def. Mot. to Strike the

Expert Report of Nancy J. Linck, Esq. at 1. On April 1, 2005, this court ruled that while Ms. Linck would be permitted to testify as to the practices and procedures of the PTO, she “may not testify as to the legality, *vel non*, of any of the actors in this litigation.” Institut Pasteur and CNRS now move this court to limit the testimony of Dr. Walter Hill and to strike portions of the reply expert report of Dr. John McDonnell on similar grounds.

**A.**

Walter Hill is a biophysicist and lawyer. In his reports, he offers a series of conclusions about “inventorship,” “best mode,” and fraud. For example, Dr. Hill describes Simon’s “inventive contributions” and opines that Simon “should have been listed as a co-inventor on this patent.” Hill Expert Report, Ex. C at 15. *See also id.* at 21. Dr. Hill defines “best mode” and opines that Simon’s contributions “should have been incorporated into the patent documents as best mode.” Ex. C, 23; *see also id.* at 23-25. Dr. Hill also makes a series of statements labeling plaintiffs’ actions as “fraudulent” (*See, e.g.* Ex D, at 17 and 21). These opinings constitute legal conclusions, not appropriate for expert testimony before a jury by Dr. Hill whether as lawyer or as biophysicist.

Dr. Hill also offers more general conclusions about the nature of “scientific discovery” (Ex. C at 2) and “what constitutes an inventor” *Id.* at 21. Despite Dr. Hill’s legal background, Simon insists that Dr. Hill is being presented solely as a scientific expert and will be offering opinions about inventorship “from a scientific standpoint, not

from a legal standpoint.” Hill Reply Report, Ex. D at 2. However, the court agrees with plaintiffs that, even if Dr. Hill does not intend to offer legal conclusions, “he is a lawyer and he is doing just that or, at best, will be perceived by the jury to be doing so.” P. Br. at 19. Therefore, Dr. Hill will not be permitted to testify about what constitutes scientific discovery or inventorship. In sum, like Ms. Linck, Dr. Hill will be prohibited from offering legal conclusions or testifying about the legality of any actors in this litigation. In particular, Dr. Hill may not offer conclusions about Dr. Simon’s “inventive contributions,” the nature of inventorship more broadly, “best mode” or plaintiffs’ allegedly fraudulent behavior.

## **B.**

John McDonnell is an organic chemist and patent lawyer retained by Simon to reply to the expert reports of Ms. Linck and Dr. Max Gottesman. He did not submit a report during either of the first two rounds of expert disclosures.<sup>1</sup> Dr. McDonnell’s reply report offers opinions about whether Simon’s research constituted “inventive contributions,” the “best mode” requirement, the “duty of candor,” and how ownership

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<sup>1</sup>Plaintiffs object to Dr. McDonnell’s testimony on the ground that he is “a brand new legal expert” witness whose report was submitted five months after initial expert disclosures were due. Each party was required to disclose the opinion of any expert as to an issue on which the sponsoring party would bear the burden of proof at trial by January 19, 2005. At that time, Pasteur submitted the expert report from Ms. Linck. Following this court’s April 1, 2005 order striking much of Ms. Linck’s opening expert report, Pasteur submitted a second report from Linck as a rebuttal report. Given the timing of the Linck report, this court does not consider the timing of Dr. McDonnell’s report alone to be a ground for striking his testimony.

and inventorship disputes affect the value of patents. Plaintiffs seek to strike Dr. McDonnell's reply report on the grounds that it is "tantamount to a legal brief" and offers improper legal conclusions. Dr. McDonnell's opinions about the "best mode" requirement, (*see* section VI) the "duty of candor," (*see* section VII), as well as the law of inventorship and whether Simon's research constituted "inventive contributions" (*see* section IV), are legal conclusions, inappropriate for expert testimony, and Dr. McDonnell will be prohibited from so opining at trial.

Institut Pasteur and CNRS also move to strike Dr. McDonnell's report on the basis that significant portions of the report are non-responsive to plaintiffs' rebuttal expert reports and, therefore, exceed the proper scope of a reply expert report. Under Fed. R. Civ. P. 26(a)(2)(C), expert reply reports are limited to testimony that is "intended solely to contradict or rebut evidence on the same subject matter identified by another party." Simon claims that section IV of the McDonnell report, entitled "Dr. Simon's Inventive Contributions," is directly responsive to the Linck rebuttal report. However, those portions of the Linck rebuttal report addressing inventorship and Simon's inventive contributions, to which Dr. McDonnell is allegedly responding, are expressly conditioned on this court permitting Dr. Hill to testify on those issues.<sup>2</sup> Because, for the reasons

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<sup>2</sup>In January 2005, plaintiffs submitted an opening expert report from Ms. Linck. On April 1, 2005, this court struck much of that report, ruling that Ms. Linck would be permitted to testify as to the practices and procedures of the PTO, but "may not testify as to the legality, *vel non*, of any of the actors in this litigation." Thereafter, plaintiffs submitted a second, new report from Dr. Linck as a rebuttal report, principally responding

discussed above, Dr. Hill will not be permitted to present the proposed testimony, there will be no occasion for Ms. Linck to rebut that testimony. As a result, section IV of McDonnell's report, insofar as it seeks to respond to Linck testimony that will not be presented, turns out to be superfluous. In contrast, sections V and VIII of McDonnell's report, to the extent that they address permitted aspects of Linck's report, are unobjectionable, and Dr. McDonnell may testify within that framework, provided that he avoids legal opining of the kind reflected in sections IV, VI and VII to which reference has been made above.

### **Russell Parr**

Russell Parr is a financial analyst retained by Simon to address the issue of damages. In his expert reply report, in addition to responding to the rebuttal reports submitted by plaintiffs' experts, Mr. Parr comments on, and expresses agreement with, the reports submitted by Vivian Lee, another damages expert also retained by Simon. After describing the content of Ms. Lee's report (*see* Parr Reply Report, Ex. B at 3-4), Mr. Parr opines, "My experience confirms [Ms.] Lee's opinion." *Id.* at 4.

Plaintiffs contend that the three paragraphs in Mr. Parr's reply report that comment on Ms. Lee's opinion exceed the proper scope for a reply report, which, under Rule

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to the proposed testimony of Dr. Hill. In addition to describing the practices and procedures of the PTO, Ms. Linck states, "If Professor Hill is permitted to testify about what determines inventorship in a patent application, then I intend to rebut his testimony, if permitted to do so, as I believe that Professor Hill is not applying the correct standards." Linck Rebuttal Report, Ex. 6, at ¶ 25.

26(a)(2)(C), is “intended solely to contradict or rebut evidence on the same subject matter identified by another party.” In particular, plaintiffs argue that Mr. Parr has utilized his reply report to “bolster” the opening report of Ms. Lee. Plaintiffs object to this testimony as untimely<sup>3</sup> and move this court to sanction Simon by excluding that portion of Mr. Parr’s testimony, pursuant to Rule 37(c)(1), which reads, in part: “A party that without substantial justification fails to disclose information required by Rule 26(a) . . . is not, unless such failure is harmless, permitted to use as evidence at a trial, at a hearing, or on a motion any witness or information not so disclosed. . . .”. This court agrees that the portion of Mr. Parr’s reply report at issue does little more than bolster Ms. Lee’s testimony. However, plaintiffs have not been unduly surprised by Mr. Parr’s comments on Ms. Lee’s report. No prejudice is apparent. Therefore, a Rule 37 sanction is inappropriate in this instance. *Cf. Johnson v. Vanguard Mfg., Inc.*, 34 Fed. Appx. 858 (3d. Cir. 2002) (prohibiting an expert witness from testifying at trial about evidence that was not included in his expert report); *Baldwin v. Graphic System, Inc. v. Siebert, Inc.*, 2005 WL 1300763 (N.D. Ill. Feb. 22, 2005) (striking expert report that challenged the validity of patents at issue for the first time in rebuttal report).

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<sup>3</sup>In their motion to strike, plaintiffs state:

To the extent such testimony would even have been permitted, it should have been included in the opening reports submitted by Dr. Simon’s experts. . . . Indeed, nothing prevented Dr. Simon’s experts from congratulating one another on the contents of their respective opening expert reports back in January” when the initial reports were submitted. Pls’ Mot. to Strike at 9.

For the foregoing reasons, it is hereby **ORDERED** that plaintiffs' motion is **GRANTED** in part and **DENIED** in part.

The motion is **GRANTED** as follows: Dr. Hill and Dr. McDonnell may not testify as to the legality, *vel non*, of any of the actors in this litigation. Accordingly, Dr. Hill may not offer conclusions about Simon's "inventive contributions," the nature of "inventorship" more broadly, "best mode," or "fraud." Dr. McDonnell may not testify to the legal opinions expressed in sections IV, VI, or VII of his reply report, and any testimony under sections V and VIII must avoid legal opining.

The balance of the motion is **DENIED**.

BY THE COURT:

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Pollak, J.

**August 16, 2005**